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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,527	03/10/2004	Roger M. Bernsen	5265.3813	2526
22235	7590	05/05/2006		
MALIN HALEY AND DIMAGGIO, PA 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316				
			EXAMINER LAVINDER, JACK W	
			ART UNIT 3677	PAPER NUMBER

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/708,527	Applicant(s) BERNSEN, ROGER M.	
	Examiner Jack W. Lavinder	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 4 have been rejected under 35 U.S.C. 102(b) as being anticipated by Driggott, 1182534.

Regarding claim 1, Driggott discloses an improved setting for gem stones for providing a self-centering temporary or permanent set for an inside bezel setting comprising:

- a housing for receiving a stone in an inside bezel mounting that includes a cylindrical passage having a smooth inner circumferential surface sized in diameter to receive a stone of substantially the same diameter regardless of its cut or shape (figure 2)
- an annular shaped spring (16, page 1, lines 110-end, page 2, lines 1-17) having a smooth outer circumferential surface with a slight opening allowing a certain amount of radial compression of the spring to reduce its diameter upon compression, said spring being sized to be slightly larger in diameter than the inside diameter of said stone receiving housing passage, said spring being positioned and mounted at a desired location

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inside said housing passage and engaging said stone to prevent said stone from being removed from said housing

- a bezel (14) including a narrowed circular passage conical in shape with one end
- face of the housing passage at the inside end of the housing passage having a diameter smaller than the diameter of the gem or the passage
- a stone (11) including a body portion that is annular and shaped to abut the housing passage narrowed annular area exposing the upper face of the stone from the housing in an inside bezel setting (14)

Regarding claim 3, Driggott discloses a round faceted gemstone (11).

Regarding claim 4, Driggott further discloses a means for fastening the spring (20, 20a) in the housing to prevent the removal of the spring.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Driggott in view of Korwin, 3670524 and Chia, 6629434.

Regarding claim 2, Driggott discloses a means for fastening the spring (20, 20a) in the housing to prevent the removal of the spring. The means for fastening comprises a detent and protrusion (20, 20a).

Driggott fails to disclose a pair of countersunk bendable prongs for securing the spring in the housing.

Korwin discloses a housing (12) for receiving an ornamentation (16), a backing member (14) for positioning the ornamentation within the housing, and a set of bendable prongs bent to a depth where the countersunk prongs contact the holding member (14).

Chia discloses a housing (3c) for mounting a gemstone including a set of countersunk bendable prongs (29, figures 12, 13) for securing the gemstone within the housing.

Both types of securing devices, i.e., the detent and protrusion and the set of prongs, perform the identical function of retaining the stone or ornamentation and the spring/backing member within the housing. It would have been an obvious design choice to a person having ordinary skill in the art to use the countersunk prongs in place of Driggott's protrusion and detent for securing the spring and gemstone within the housing, since they both perform the same function and the specification fails to disclose any criticality to the use of the prongs over other type of retaining devices.

Regarding claim 5, Driggott in view of Korwin and Chia discloses all the method steps associated with the formation of the gemstone setting (see above).

Response to Arguments

5. Applicant's arguments filed 2/17/2006 have been fully considered but they are not persuasive. The applicant argues on page 1, paragraph 1 of their remarks that "The problem with the Driggott device is that the clamping device can be mounted only in one fixed position..." This argument is moot with respect to claims 1-3 and 5. Claims 1-3 and 5 only require that the clamping device be mounted in a desired position. Driggott's clamping device is mounted in a desired locking position.

With respect to claim 4, Driggott's device is capable of mounting the clamping device (16) in a multitude of positions, albeit with only one locked position wherein the small smooth protrusion (20) engages the small smooth indentation (20a, figure 4). The device will still function in the other position, but not quite as good as in the locked position. The only requirement to be met in the claim is that Driggott's device be capable of being mounted at a desired depth to accommodate the different crown pavilion angles. Driggott's device has this capability.

The applicant argues on page 2, first paragraph, that Korwin's prongs are surface exposed. Korwin's prongs are countersunk within the recesses (30) as required by claims 2 and 5. The applicant also argues that Korwin and Chia are absent teachings for "temporary placement of discs or three dimensional stones which would actually provide the customer the opportunity to wear and if so desired to change the insertable object, then permanently set when desired."

This argument is moot because it fails to address the claimed limitations. There is no mention of "temporary placement of discs or three dimensional stones which

would actually provide the customer the opportunity to wear and if so desired to change the insertable object, then permanently set when desired” in claims 2 and 5.

The applicant argues on page 2, that the countersunk prongs in engagement with the spring is not disclosed in the prior art. Korwin discloses countersunk prongs (20) in engagement with a spring-like backing member. This in combination with the other references would motivate a person having ordinary skill in the art to use the prongs as an alternative to the locking detent for holding the clamping device on the setting. The both perform the identical function of locking the clamping device and gemstone or ornament within the setting equally as well as the other. Furthermore, the applicant has failed to disclose any criticality with the use of the prongs for locking the gemstone in the setting.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack W. Lavinder
Primary Examiner
Art Unit 3677

5/2/06